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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VO, TRUONG V	
			ART UNIT	PAPER NUMBER
			2169	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/564,183

**Applicant(s)**

NAKAYAMA ET AL.

**Examiner**

TRUONG V. VO

**Art Unit**

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,8-10,12,16,17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8-10,12,16,17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/22/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to communications filed May 27, 2008.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-2, 4, 8-10, 12, 16-17 and 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Status of Claims***

3. Claims 1-2, 4, 8-10, 12, 16-17 and 19 are pending, of which claims 1, 9, 17 and 19 are in independent form. Claims 1-2, 4, 8-10, 12, 16-17 and 19 are objected to. Claims 7, 9-10, 12, 16 and 19 are rejected under 35 U.S.C. 101. Claims 1-2, 4, 8-10, 12, 16-17 and 19 are rejected under 35 U.S.C. 102 (e).

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: For example, claim 1 discloses "a memory..." but in the specification does not explicitly disclose "a memory...". Therefore, claims 1-2, 4, 8-10, 12, 16-17 and 19 are objected to.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 9-10, 12, 16 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is not statutory for the following reasons:

The claims lack the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101.

For example, claim 9 discloses "...a memory configured to store..." however, in the original disclosure does not explicitly disclose "a memory". Therefore, the claim does not inherently mean is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or combination of devices to be a machine within the meaning of 101.

They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be

statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare in re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

7. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is not statutory for the following reasons:

Computer-readable recording medium (defined in the original disclosure as including transmission, etc.):

The claims fail to place the invention squarely within one statutory class of invention. On page 30 lines 26-27 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefor this claim(s) is/are non statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4, 8-10, 12, 16-17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohsaki et al. (US Patent No. 6,985,938 B2).

10. **Regarding claim 1**, (Currently Amended) Ohsaki teaches a system management method for associating at least a process object and at least a process that should be- executed for each process object with each node in a tree structure, and operating each node based on the tree structure so as to manage the process object and the process (i.e., the expression "Project=Field(ID)+Sub-route: bumon" shown in FIG. 18(a) means that "A node for referring to project type data generates and executes child processes as an activity of the node by using a definition of a project referred to by the node. Also to generate and execute child processes using the same project "bumon", the node can circulate data to different users (or departments) by separately setting IDs of the child processes, that is, the name data thereof; [col. 6 lines 41-49])).

Ohsaki teaches registering, in a memory, a user ID to be uniquely assigned to each registered user that performs operations for a node providing a general node corresponding to the process object and a function node that is a program for performing a process (i.e., the user management program 34 controls the authorization of persons in charge to participate in the workflow system. Thus, the user management program 34 registers user information in the user information storage 39 and makes access to the user information as needed...In the project "definition A" shown in FIG. 4(a), when a process using the project "definition A" is started, a person in charge of an activity corresponding to the Node A is first assigned to a person who is substituted for process data User ID. After the end of the activity, an activity corresponding to a Node B is assigned to a superior of the user who has executed the activity of the Node A; [col. 9 lines 46-67 and col. 10 lines 1-23]).

Ohsaki teaches setting the function node as a child node of the general node corresponding to the process object for which the process corresponding to the function node should be performed (i.e., since `bumon.sub.--prj` is set as the prototype attribute of the project, child processes created as the activity of the node by using the project of a project definition ID (`bumon.sub.--prj`) are set, and then the values are set to data in the child processes, that is, the variable IDs. To operate a slip as duty processing, the node generates as many child processes as array elements and executes the child processes in parallel, because the node is set so as to refer to a project type array; [col. 6 lines 56-64]).

Ohsaki teaches setting the general node as a parent node of the function node (i.e., first, when the client request management program 33 receives a request to set the value, an evaluation logic is called using the current process "definition C: C001" as a "parent process" (step S101); [col. 11 lines 51-54]).

Ohsaki teaches storing information of the set child node into the memory by associating the information with the general node that is the parent node (i.e., storing means for storing a program for causing a computer to execute the steps of introducing as one node of a workflow a node that includes a project type variable capable of handling a combination of a data set and a route integrally, and designating the project type variable as an array, thereby treating as one node a plurality of child processes to be branched synchronously; and transmitting means for reading out the program from the storing means and transmitting the program; [col. 4 lines 58-67]).

Ohsaki teaches setting registered user operation authority, of each user ID for each registered user for each of the general nodes, and storing the registered user operation authority into the memory by associating the registered user operation authority with the general node (i.e., the user management program 34 controls the authorization of persons in charge to participate in the workflow system. Thus, the user management program 34 registers user information in the user information storage 39 and makes access to the user information as needed. When a new user attempts to log on the system by using the manipulating computer terminal 20, the user management program 34 checks an ID and a password entered by the user. The user information storage 39 retains information such as organizations which users belong to, hierarchical



structures of the organizations, relationships between the users and their superiors, and the range of the authorities of the users. Reference is made to the information to assign a person in charge to a next activity; [col. 9 lines 46-59]).

Ohsaki teaches setting function node operation authority for each of function nodes, and storing the function node operation authority in the memory by associating the function node operation authority with the general node (i.e., FIGS. 4(a) and 4(b) are illustrations of an example of a registered project. In this case, it is assumed that a project "definition A" and a project "definition B" are previously registered. The projects are registered as a unit of a combination of the workflow definition and the data definition...In the project "definition A" shown in FIG. 4(a), when a process using the project "definition A" is started, a person in charge of an activity corresponding to the Node A is first assigned to a person who is substituted for process data User ID...In the project "definition B" shown in FIG. 4(b), when a process using the project "definition B" is started, the person in charge of the activity corresponding to the Node A is first assigned to the person who is substituted for the process data User ID. After the end of the activity, a person in charge of an activity of a Node C is assigned to a person who is substituted for process data Reviewer. Furthermore, a person in charge of the activity corresponding to the Node B is assigned to the superior of the user who has executed the activity of the Node A. The project "definition A" has a "definition A" as the definition ID, and the project "definition B" has a "definition B" as the definition ID, respectively; [col. 9 lines 65-67 and col. 10 lines 1-23]).

Ohsaki teaches causing the function node to execute the process only when the process is permitted by the registered user operation authority, of the registered user requesting the process, set in the general node that is a parent node of the function node, and, when execution of the process corresponding to the function node is requested by any function nodes, causing the function node to execute the process only when the process is permitted by the function node operation authority, of the function node that requests the process, set for the general node that is the parent node of the function node (i.e., to operate the slip, the node generates as many child processes as array elements and executes the child processes in parallel, because the node is set so as to refer to the project type array. At this time, the different project IDs (soumu.sub.--prj, keiri.sub.--prj and eigyou.sub.--prj) are evaluated, and different types of child processes are set. Routes defined by the separate projects are used, and data is transmitted to the departments by using the separate routes to be approved by the respective persons in charge in the departments. The child processes go to a next node in synchronization with one another; [col. 7 lines 13-26]. First, when the client request management program 33 receives a request to set the value, an evaluation logic is called using the current process "definition C: C001" as a "parent process" (step S101). Then, the first data name portion of the data name to be substituted is set for "Evaluation data name" (step S102). Then, an array subscript portion of the first data name of the data name to be substituted is set for "INDEX" (step S103). Then, a portion of the substitution data name excluding Evaluation data name and INDEX is set for "Remaining phrase" (step S104). Since the substitution data name is "Depts[1]. UserID",

"Depts", "[1]" and "UserID" are obtained as "Evaluation data name", "INDEX" and "Remaining phrase", respectively; [col. 11 lines 51-64]).

11. **Regarding claim 2**, (Currently Amended) Ohsaki teaches setting, for each of the general node, non-registered user operation authority that is operation authority of a non-registered user and storing the non-registered user operation authority in the means memory by associating the non-registered user operation authority with the general node (i.e., when a new user attempts to log on the system by using the manipulating computer terminal 20, the user management program 34 checks an ID and a password entered by the user. The user information storage 39 retains information such as organizations which users belong to, hierarchical structures of the organizations, relationships between the users and their superiors, and the range of the authorities of the users; [col. 9 lines 51-58]).

Ohsaki teaches causing the function node to execute the process only when the process is permitted by the non-registered user operation authority set for the general node that is the parent node of the function node, when execution of the process corresponding to the function node is requested by the non-registered user (i.e., a node for referring to project type data generates and executes child processes as an activity of the node by using a definition of a project referred to by the node. Also to generate and execute child processes using the same project "bumon", the node can circulate data to different users (or departments) by separately setting IDs of the child processes, that is, the name data thereof; [col. 6 lines 42-49]).

12. **Regarding claim 3, (Canceled).**

13. **Regarding claim 4, (Currently Amended)** Ohsaki teaches sending a message in which at least any one of the function node or the user is a sending origination and at least any one of function nodes is a destination, detecting presence or absence of execution of a predetermined event process at the sending origination, and sending the message received from the sending origination according to the detection result (i.e., see FIG. 2A).

Ohsaki teaches receiving the message to the destination, when receiving the message, sending a message having the destination as a sending origination to the destination or causing the destination to execute a predetermined event process according to a condition that is set beforehand (i.e., when the client request management program 33 receives a request to set the value, an evaluation logic is called using the current process "definition C: C001" as a "parent process" (step S101). Then, the first data name portion of the data name to be substituted is set for "Evaluation data name" (step S102). Then, an array subscript portion of the first data name of the data name to be substituted is set for "INDEX" (step S103). Then, a portion of the substitution data name excluding Evaluation data name and INDEX is set for "Remaining phrase" (step S104). Since the substitution data name is "Depts[1]. UserID", "Depts", "[1]" and "UserID" are obtained as "Evaluation data name", "INDEX" and "Remaining phrase", respectively; [col. 11 lines 51-64]).

14. **Regarding claims 5-7, (Canceled).**
15. **Regarding claim 8, (Currently Amended)** Ohsaki teaches receiving only a message sent from a sending origination set in a predetermined access list (i.e., see FIG. 9A).
16. **Regarding claim 9, (Currently Amended)** is essentially the same as claim 1 except that it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied hereinabove.
17. **Regarding claim 10, (Currently Amended)** is essentially the same as claim 2 except that it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied hereinabove.
18. **Regarding claim 11, (Canceled).**
19. **Regarding claim 12, (Previously Presented)** is essentially the same as claim 4 except that it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied hereinabove.
20. **Regarding claims 13-15, (Canceled).**

21. **Regarding claim 16**, (Previously Presented) is essentially the same as claim 8 except that it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied hereinabove.
22. **Regarding claim 17**, (Currently Amended) is essentially the same as claim 1 except that it sets forth the claimed invention as a computer-readable recording medium rather than a method and rejected for the same reasons as applied hereinabove.
23. **Regarding claim 18**, (Canceled).
24. **Regarding claim 19**, (New) is essentially the same as claim 9 and rejected for the same reasons as applied hereinabove.

### ***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Truong V. Vo whose telephone number is (571) 272-1796. The Examiner can normally be reached on Mon.-Thr. 7:30a.m.-5p.m..

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Pierre Vital can be reached on (571) 272-4215. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 11, 2008

Art Unit: 2169

Truong Van Vo

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